REMARKS

Reconsideration and withdrawal of the rejection and the allowance of all claims now pending in the above-identified patent application (*i.e.*, Claims 26-37 and 39-72) are respectfully requested in view of the foregoing amendments and the following remarks.

At the outset, the present invention provides a method of playing a group participation wagering game in combination with an individual participation game, with the present application representing a continuation application having a foreign priority claim of August 27, 1993. Several claims of this continuation application are variations of, or were previously copied from, Tracy *et al.*, U.S. Patent No. 6,692,354, issued February 17, 2004. Specifically, Claims 40-65 were copied exactly from Tracy *et al.* on June 4, 2004, in response to a requirement of the prior Examiner, as issued as part of the first Office Action, dated May 24, 2004. In the second Office Action, issued September 9, 2004, the prior Examiner had "allowed" Claims 40-65, as exactly copied from Tracy *et al.*

In the third Office Action, issued January 22, 2007, the Examiner to whom further examination has now been assigned has withdrawn the prior allowance of Claims 40-65 and has now rejected these claims, pursuant to 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement on the ground that Applicant's Specification, as originally-filed, did not provide subject matter support for the limitation of independent Claim 40 (and other claims having substantially the same limitation), which read: "a secondary game award amount being equal to the product of the primary game award amount multiplied by the multiplier value." The Examiner agreed that Applicant's

Specification did teach a type of award "multiplier," though not precisely the "multiplier value" recited originally recited in Claims 40-65.

Accordingly, Applicant has herein amended Claims 40, 46, 48, 49, 52-54, 57, 59 and 63-65 to broaden such claims in a manner in which Applicant submits finds support in his originally-filed Specification, taking into consideration the Examiner's comments presented (in the third Office Action at Page 2) as part of the 35 U.S.C. §112, first paragraph, rejection. Applicant therefore respectfully submits that the 35 U.S.C. §112, first paragraph, rejection of Claims 40-65 should now be appropriately withdrawn.

In the third Office Action, the Examiner has also rejected Claims 26-37 and 39 (Claim 38 having previously been canceled) as being obvious, pursuant to 35 U.S.C. §103(a), over Jones *et al.*, U.S. Patent No. 4,861,041, taken in view of Jones *et al.*, U.S. Patent No. 5,377,973. Further, Claims 66-72 have been rejected as being anticipated, pursuant to 35 U.S.C. §102(e), by Jones *et al.*, U.S. Patent No. 5,377,973.

In Applicant's *Amendment in Response to the Second Office Action*, filed September 24, 2004, Applicant suggested that Jones *et al.*, U.S. Patent No. 5,377,973, which is based upon a continuation-in-part application filed March 14, 1994, was not citable against the claims of the present continuation application in light of Applicant's foreign priority claim based upon an Australian patent application, filed August 27, 1993.

In the third Office Action, the Examiner responded to Applicant's earlier argument regarding the application as "prior" art of Jones *et al.*, U.S. Patent No. 5,377,973,

by pointing out that Jones *et al.*, U.S. Patent No. 5,078,405, which carries a filing date prior to Applicant's foreign priority claim, is a "parent application" of Jones *et al.*, U.S. Patent No. 5,377,973, and suggesting that the earlier Jones *et al.* patent had a similar disclosure and, thus, the citation of Jones *et al.*, U.S. Patent No. 5,377,973, was therefore otherwise proper.

In the latest Office Action, the Examiner has secondary-applied Jones *et al.*, U.S. Patent No. 5,377,973, in the obviousness rejection of Claims 26-37 and 39, and has applied this same patent in the anticipation rejection of Claims 66-72, for its disclosure of the features of FIG. 3 of U.S. Patent No. 5,377,973, its attendant description in the text of the Specification of this patent, as well as citing to Claims 1-20 of this same patent. A careful review of Jones *et al.*, U.S. Patent No. 5,078,405, as well as the other related patents referenced by Jones *et al.*, U.S. Patent No. 5,377,973, finds that none of the prior Jones *et al.* patents in the string of continuations, or continuations-in part, applications discloses the subject matter of FIG. 3 of U.S. Patent No. 5,377,973. The subject matter being cited in Jones *et al.*, U.S. Patent No. 5,377,973 is, consequently, the "new matter" in the continuation-in-part application filed by Jones *et al.* on March 14, 1994, and which ultimately issued as U.S. Patent No. 5,377,973. As such, the subject matter of Jones *et al.*, U.S. Patent No. 5,377,973, as applied by the Examiner against Claims 26-37, 39 and 66-72, is entitled to a "prior art" date no earlier than March 14, 1994, which is, of course, subsequent to Applicant's foreign priority claim.

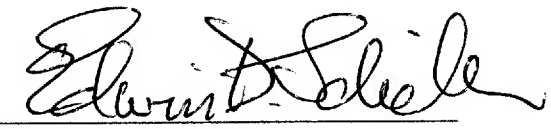
In light of the fact that Jones *et al.*, U.S. Patent No. 5,377,973, is being applied for

its disclosure of subject matter not found in any parent application of this patent, it is respectfully contended that Jones *et al.*, U.S. Patent No. 5,377,973, is not properly citable as "prior art" against Applicant's claims in the instant continuation application and, thus, the 35 U.S.C. §103(a) obviousness rejection of Claims 26-37 and 39, as well as the 35 U.S.C. §102(e) anticipation rejection of Claims 66-72 – both of which apply Jones *et al.*, U.S. Patent No. 5,377,973 – should be appropriately withdrawn.

In light of the foregoing, it is respectfully contended that all claims now pending in the above-identified patent application (*i.e.*, Claims 26-37 and 39-72) recite a novel method and related apparatus for playing a gambling game, which is patentably distinguishable over the prior art. Accordingly, withdrawal of the outstanding rejections and the allowance of all claims now pending are respectfully requested and earnestly solicited.

Respectfully submitted,

CHRISTOPHER R. BYRNE

By 

Edwin D. Schindler
Attorney for Applicant
Reg. No. 31,459

PTO Customer No. 60333

Five Hirsch Avenue
P. O. Box 966
Coram, New York 11727-0966

(631)474-5373

February 21, 2007

The Commissioner for Patents is hereby authorized to charge the Deposit Account of Applicant's Attorney (*Account No. 19-0450*) for any fees or costs pertaining to the prosecution of the above-identified patent application, but which have not otherwise been provided for.